

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	Method of Generating Revenue
)	From the Right To Display
BRADLEY EMALFARB)	Advertising Information...
)	
Serial No. 10/601,390)	Examiner: Alvin L. Brown
)	
Filed: June 23, 2003)	Group Art Unit 3622

APPELLANT'S REPLY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant replies to the Examiner's Answer, mailed on January 31, 2012,
as follows.

In the last full paragraph on page 9 of the Examiner's Answer, the
Examiner relies on a passage from Keach. Keach was applied by the Examiner earlier
in the prosecution, but has not been relied upon in any of the rejections being appealed
herein.

In the bottom paragraph on page 11 of the Examiner's Answer, the
Examiner repeats Appellant's argument that "The Examiner does not cite any portion of
Kalt that allegedly is directed to a corresponding revenue generation associated with the
signage therein." The Examiner argues that "while Kalt mentions advertising in the
background section, it is Turnpike that particularly discusses 'revenue generation
associated with the signage'".

In paragraph 5 on page 3 of the Final Action, the Examiner, describing the primary Kalt reference, states that "Kalt discloses a method of generating revenue from the right to display advertising information on or adjacent to a public right-of-way..."

Appellant's referenced argument was made since it was the Examiner's starting premise in rejecting the claims that Kalt discloses a method of generating revenue from the right to display advertising information on or adjacent to a public right-of-way. The fact that Kalt, the Examiner's primary reference, does not make such a disclosure of revenue generation makes the next step of modification thereto to arrive at a specific revenue generation method, as claimed, even less appropriate.

In the second full paragraph on page 12 of the Answer, which spans to claim 13, the Examiner repeats one of Appellant's arguments and argues, with supporting law, that limitations from the specification are not to be read into the claims.

While the Examiner does not make clear what argued limitations are allegedly lacking from the claims, the limitations that appear to be the focus of the Examiner's argument are those relative to both "navigational and advertising technology." However, claim 1 clearly defines and differentiates a "first type of information on the support", that relates to navigation, from a "different type" of information on the same support, that relates to advertising.

It is respectfully submitted that the limitations to which the Examiner refers are clearly set forth in the claims.

On page 14 of the Examiner's Answer, in the paragraphs leading up to the last heading "(11) Related Proceeding(s) Appendix", the Examiner cites to arguments made beginning on page 11 of Appellant's Brief on Appeal. Appellant emphasizes in

the identified arguments that navigational signage on public right-of-ways has unused sides. *Turnpike* does not lead one to use unused sides of navigational signage, but instead introduces a completely separate category of signage with two-sided advertising. Appellant admitted that two-sided billboards have existed and that revenue is generated therefrom. However, *Turnpike*, and any other technology that uses two-sided advertising, would not motivate someone skilled in the art to take advantage of unused space on existing signage, that is used for navigational purposes and is "conventionally placed by federal or local authorities that maintain and/or regulate public right-of-ways to aid the navigation of vehicles on the public right-of-way", to place revenue generating advertising information, as required in claim 1.

Turnpike would, at best, motivate someone skilled in the art to provide a completely separate collection of signage that is unrelated to that associated with vehicle navigation on public right-of-ways, as set forth in claim 1.

Accordingly, it is requested that the Board reverse the rejection of all of claims 1-22, currently on appeal.

Respectfully submitted,

WOOD, PHILLIPS, KATZ,
CLARK & MORTIMER

By


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Dated: March 15, 2012

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